

Remarks/Arguments

The present application is a non-provisional application which claims priority of a provisional application filed on May 5, 1999. In the Final Rejection dated June 6, 2003 the claims were rejected under 35 U.S.C. § 102 over McNally et al. (Bioorg. Med. Chem. Lett., 2000) on the ground that McNally teaches the compounds, compositions and methods of use of the instant invention. Although the McNally reference has a publication date of February 7, 2000, which is after applicant's priority date, the Examiner has maintained that applicants are not entitled to the priority date of the provisional application and that the McNally reference, therefore, is a valid reference.

Applicants wish to point out that the James N. McNally listed as an author in the reference and the James McNally listed as a co-inventor in the present application are one and the same.

The reaction scheme employed by applicants in the present invention produced two possible regiomer ic amides, one wherein the Y-L-Z side chain is attached directly to the exocyclic nitrogen and one wherein the Y-L-Z side chain is attached directly to the nitrogen in the five membered ring. Although both regiomer ic amides were disclosed in the provisional application, when the provisional application was filed on May 5, 1999 it was believed that the point of attachment in the main component produced by the reaction was at the nitrogen in the five membered ring. Subsequently it was determined that the point of attachment of the Y-L-Z side chain in the main component was on the exocyclic nitrogen. The correct structure is illustrated in the McNally paper and claimed in the present application.

The non-provisional application in which the correct structure was claimed was filed on April 20, 2000. Although the filing date of the application is after the publication date of the reference, since both inventors are listed as authors on the publication, it stands to reason that the invention described and claimed in the non-provisional application was invented prior to the publication date of the reference.

Applicants are submitting herewith a Declaration under 37 C.F.R. 1.131 in which they declare that the invention described and claimed in the above identified application was conceived by them in this country prior to the publication date of the reference and that such conception was coupled with due diligence by them in this country from just prior to that date to a reduction to practice of the invention. Since applicants clearly invented the invention

described in the non-provisional application prior to the publication date of the reference, it is submitted that the McNally reference is not a valid reference against the non-provisional application.

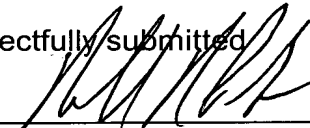
Reconsideration of the rejection of the claims under 35 U.S.C. § 102 is courteously requested.

In the final rejection the Examiner indicated that claim 19 stood withdrawn from consideration along with claims 15-18 because claim 19 was amended to be dependent on claim 15 which had been previously withdrawn from consideration. In the amendment filed on November 20, 2003 claim 19 was amended to be dependent on claim 1. A closer comparison of claims 2 and 19 revealed that the claims, although similar, are not identical. The difference is found in the definition of "L" which is not identical in both claims. The Examiner was requested to reconsider the withdrawal of claim 19.

In the Advisory Action dated January 14, 2004 it was noted that the proposed amendment in the reply filed on November 20, 2003 was not entered. In the claims as originally filed claim 19 was dependent on claim 1. In a paper filed on January 19, 2001 claim 19 was made dependent on claim 15 in response to an objection raised by the Examiner. Upon realizing that claim 15 had been withdrawn from reconsideration as the result of a restriction requirement in the amendment filed on November 20, 2003 claim 19 was amended to read on claim 1 to conform to the application as filed. By the present amendment claim 19 has been amended to read on claim 1. It is submitted that claim 19, although similar to claim 2, is not a duplicate of claim 2 as surmised by the Examiner. The Examiner is requested to reconsider the withdrawal of claim 19.

This being the only outstanding rejection, it is believed that all of the outstanding rejections and objections have been removed. Applicants respectfully request that a timely Notice of Allowance be issued in this application.

Respectfully submitted



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